

**RECEIVED  
CENTRAL FAX CENTER**

FEB 28 2005

Atty Docket No. 019009-000420US

PTO FAX NO.: (703) 872-9306

ATTENTION: Appeal Briefs - Patents/Examiner Chuong T. Ho

Group Art Unit 2664

**OFFICIAL COMMUNICATION  
FOR THE PERSONAL ATTENTION OF**

**Appeal Briefs - Patents/EXAMINER Chuong T. Ho**

**CERTIFICATION OF FACSIMILE TRANSMISSION**

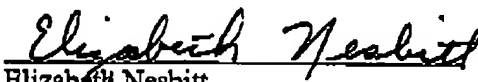
I hereby certify that the following document(s) in re Application of Stephen Y.F. Pang, Application No. 09/353,537, filed July 14, 1999 for SYSTEM FOR POLICING JUNK E-MAIL MESSAGES is being facsimile transmitted to the Patent and Trademark Office on the date shown below.

Document(s) Attached

1. Transmittal Form (1 pg.);
2. Fee Transmittal (in dupl., 2 pp);
3. Appellants' Brief in Support of Appeal Under 37 CFR 1.192 (in trip., 39 pp).

Number of pages being transmitted, including this page: 43

Dated: February 28, 2005

  
Elizabeth Nesbitt

**PLEASE CONFIRM RECEIPT OF THIS PAPER BY  
RETURN FACSIMILE AT (415) 576-0300**

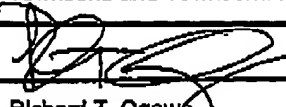
TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834  
Telephone: 650-326-2400  
Fax: 650-326-2422

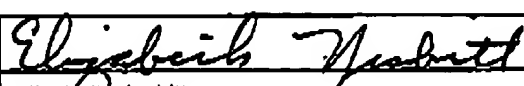
60412739 v1

PTO/SB/21 (09-04)

<b>TRANSMITTAL FORM</b>  <small>(to be used for all correspondence after initial filing)</small>	Application Number	09/353,537
	Filing Date	July 14, 1999
	First Named Inventor	Pang, Stephen Y.F.
	Art Unit	2664
	Examiner Name	Chuong T. Ho
	Attorney Docket Number	019009-000420US
Total Number of Pages in This Submission		

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement  <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Postcard
Remarks: The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT			
Firm Name	Townsend and Townsend and Crew LLP		
Signature			
Printed name	Richard T. Ogawa		
Date	February 28, 2005	Reg. No.	37,692

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office, Fax No. (703) 872-9306 on February 28, 2005.			
Signature			
Typed or printed name	Elizabeth Nesbitt	Date	February 28, 2005

60432835 v1

PTO/SB/17 (12-04)

Effective on 12/09/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818). <h1 style="text-align: center;">FEE TRANSMITTAL</h1> <h2 style="text-align: center;">For FY 2005</h2>		<b>Complete if Known</b> Application Number <u>09/353,537</u> Filing Date <u>July 14, 1999</u> First Named Inventor <u>Pang, Stephen Y.F.</u> Examiner Name <u>Chuong T. Ho</u> Art Unit <u>2884</u> Attorney Docket No. <u>019009-000420US</u>	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
TOTAL AMOUNT OF PAYMENT	(\$) 250		

**METHOD OF PAYMENT (check all that apply)**

☐ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): \_\_\_\_\_  
☒ Deposit Account Deposit Account Number: 20-1430 Deposit Account Name: Townsend and Townsend and Crew LLP  
 For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)  
☒ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, except for the filing fee  
☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments  
**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038

**FEE CALCULATION****1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Small Entity	Fee (\$)	Small Entity	Fee (\$)	Small Entity	Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

**2. EXCESS CLAIM FEES**

				Small Entity	
Fee Description				Fee (\$)	Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent				50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent				200	100
Multiple dependent claims				360	180
<u>Total Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>	<u>Multiple Dependent Claims</u>	
	-20 or HP = _____ x _____ = _____			<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>
HP = highest number of total claims paid for, if greater than 20					
<u>Indep. Claims</u>	<u>Extra Claims</u>	<u>Fee (\$)</u>	<u>Fee Paid (\$)</u>		
	-3 or HP = _____ x _____ = _____				
HP = highest number of independent claims paid for, if greater than 3					

**3. APPLICATION SIZE FEE**

If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____	_____	_____
$\text{HP} - 100 = \text{_____} / 50 = \text{_____}$ (round up to a whole number) x _____ = _____				


**4. OTHER FEE(S)**

Non-English Specification, \$130 fee (no small entity discount)

Other: Filing a brief in support of an appeal

Fees Paid (\$)

250

<b>SUBMITTED BY</b>		
Signature		Registration No. (Attorney/Agent) <u>37,692</u>
Name (Print/Type)	<u>Richard T. Ogawa</u>	Telephone <u>650-326-2400</u>
		Date <u>February 28, 2005</u>

60432765 v1

I hereby certify that this correspondence is being facsimile transmitted to  
the United States Patent and Trademark Office,  
Fax No. (703) 872-9306, on February 28, 2005

Attorney Docket No.: 019009-000420US PATENT

TOWNSEND and TOWNSEND and CREW LLP

By: Elizabeth Nesbitt

**RECEIVED**  
**CENTRAL FAX CENTER**

FEB 28 2005

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Stephen Y.F. Pang

Application No.: 09/353,537

Filed: July 14, 1999

For: SYSTEM FOR POLICING JUNK  
E-MAIL MESSAGES

Examiner: Chuong T. Ho

Art Unit: 2664

APPELLANTS' BRIEF IN SUPPORT OF  
APPEAL UNDER 37 C.F.R. § 1.192

Commissioner for Patents  
P.O. Box 1450  
Arlington, VA 22313-1450

Sir:

This is an appeal brief in support of an appeal from the final office action  
mailed on September 21, 2004 rejecting claims 1-20 in the present application.

REAL PARTY IN INTEREST

The real party in interest is Stephen Y. Pang residing at 515 Barron Street,  
Menlo Park, California 94025.

RELATED APPEALS AND INTERFERENCES

Appellant is not aware of any related appeals or interferences.

STATUS OF CLAIMS

Claims 1-20 were pending. Claims 1-20 were variously rejected under 35  
USC §103(a) as being unpatentable over McCormick et al., U.S. Patent No. 6,023,723  
("McCormick") in view of "Here is a zmail ban-spam button," 07 October 1997 ("Zmail")  
and further in view of Courtney Macavinta (Staff Writer, CNET News.com "June 12,  
1997") ("Courtney"). The final rejection of claims 1-20 mailed September 21, 2004 is the

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 2

PATENT

subject of the present appeal. An appendix to this appeal brief contains a copy of the pending claims.

#### STATUS OF AMENDMENTS

Appellant prepared and filed a Response on June 30, 2004 adding claims 13-20. A responsive Office Action was mailed September 21, 2004 rejecting claims 1-20. Claims 1-20 therefore remain in the form pending at the time of the final rejection.

#### SUMMARY OF INVENTION

The present invention relates to a "pro-active" system that reduces the incidence of unsolicited e-mail communications. The references provided by the Examiner, at best, appears to disclose a passive filter based system, which have limitations of the prior art.

As discussed in the Background of the Invention, unsolicited e-mail communications, SPAM, has become a burdensome nuisance for most users of e-mail messaging. To battle SPAM, various embodiments of the present invention disclose a system that allows e-mail users to request removal from a SPAM mailing lists and that enforces or polices their requests. The specification discloses embodiments enabling e-mail users to request the removal in Figs. 4 and 5. As can be seen, the request can be initiated by the identification of an e-mail message, and in one embodiment, selection of a dedicated, user-selectable button, labeled "SPAM" in Figs. 4 and 5. Other buttons or user interface indications may also be used.

In operation, one or more receivers 1000 (Fig. 10) of SPAM, selects the SPAM button and causes the removal request to be sent to the spammer 1010, step 1110 (Fig. 11). The removal request and associated data are stored in an evidentiary log, steps 1120-1130. Subsequently, in one embodiment, if the spammer 1010 ignores the removal request, and sends another SPAM message to the requester, step 1140, the spammer is in "violation" of the request.

In various embodiments, the system then enforces or polices the removal request after the violation is detected. In some embodiments, the notice of the violation, the evidentiary log, and the like are sent to one of a number of destinations for enforcement actions, such as to ISPs, steps 1160-1170, to a government authority, p. 20, line 8, to a "Junk E-mail Database Server," or the like. Servers that can report-out the violations are termed "policing servers." For example, the provisional application, incorporated by reference discloses:

*The method includes a step of tracking or logging violations (i.e., repeated SPAM messages to a specific receiver after the receiver requested to be removed) from a sender at a client, an ISP, or another server through a "policing" server, which is any server that can report out violations of a sender. In some embodiments, the policing server transmits a violation message to the sender, as a last threat before possible disconnection. In other embodiments, the policing server also requests the ISP, which is being used by the sender, to disconnect the sender. Still further, the*

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 3

PATENT

*policing server can transmit a violation message to enforcement agents such as governmental authorities and the like. These authorities may impose fines and other penalties to the sender. In drastic cases, the policing server transmits a "virus" or transmits large volumes of junk e-mail to the sender to tie up and/or lock up the sender. Furthermore, the policing server can send a message to a law firm that will file a legal action against the sender, as well as serve the sender via e-mail or other electronic technique. Provisional Application 60/093,120, p. 3.*

The patent specification also discussed specific types of enforcement or policing actions, such as notifying the spammer's ISP 1020 that the spammer is in violation of ISP 1020's policies, p. 19, lines 27-31. Other types of enforcement or policing actions include the demand for statutory fines or penalties from the spammer, p. 17, lines 16-19; and / or the referral of the violation to governmental authorities for enforcement, p. 20, lines 11-12, p. 22, lines 15. Additional types of enforcement or policing actions include the referral of the violation to central clearing houses, p. 21, lines 4-10, or submission of the violation to centralized black-lists, p. 22, lines 15-22.

In various embodiments of the present invention, upon the first occurrence of a SPAM message, the SPAM is reported to SPAM servers, p. 23, lines 30-34, "SPAM policing servers," p. 24, lines 1-3. For example, the specification states:

For example, as described above, reporting of SPAM may occur [on] the first "bite of the SPAM apple," not only when the spammer takes the second "bite of the SPAM apple." P. 23, lines 25-28.

In light of the above, the system is termed "proactive" because when SPAM is received, the system performs policing actions to stem the tide of SPAM: getting ISP 1020 to terminate the spammer's account, referring the incident to ISPs or Governmental bodies to legally force the spammer to stop, obtaining judgments of statutory or actual damages from the spammer, and the like. The policing server thus performs actions to reduce the further incidence of SPAM.

In operation, for example, if ten copies of the same unwanted e-mail message are received, in various embodiments, embodiments of the present system performs actions to legally, monetarily, or effectively penalize the spammer for the SPAM. The embodiments are therefore "pro-active" measures, and the cost of fighting SPAM is shifted to the spammer.

The description of above is only intended to assist the Board of Appeals to understand certain aspects of the present invention and should not be unduly limiting the scope of the claims pending in the subject application.

#### GROUND OF REJECTION PRESENTED FOR REVIEW

A. Claims 1, 3, 4, 6-10, 13, 15, 16, 18 and 19 stand rejected under 35 USC §103(a) as being unpatentable over McCormick and Zmail.

B. Claims 2 and 14 stand rejected under 35 USC §103(a) as being unpatentable over McCormick and Zmail.

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 4

PATENT

C. Claims 5 and 17 stand rejected under 35 USC §103(a) as being unpatentable over McCormick and Zmail.

D. Claims 11, 12 and 20 stand rejected under 35 USC §103(a) as being unpatentable over McCormick and Courtney.

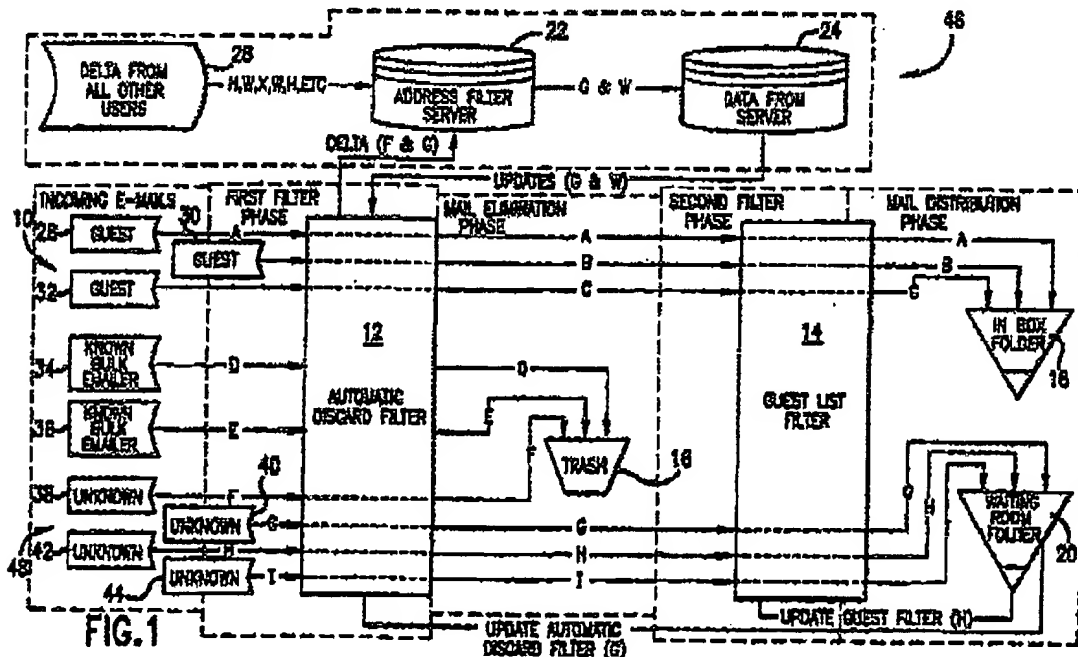
### ARGUMENT

#### Cited Prior Art

Before addressing the claims, the cited references are briefly discussed.

McCormick, as understood, discloses a "reactive" system that merely filters-out unwanted e-mail messages but does nothing to prevent them from being sent from "spammers" in the first place. Specifically, McCormick discloses an e-mail system that provides e-mail "filter-out" and "filter-in" lists for its users.

As seen in Fig. 1, McCormick discloses a typical user computer 48 and a server 46 that provides e-mail filter lists, which is a passive system. As described in McCormick, "automatic discard filter" ("filter-out" list) 12 is provided by server 26, and incoming e-mails (A-I) are filtered through "automatic discard filter" 12 in a first filter phase. Next, the remaining e-mails (A-C and G-I) are filtered through a "guest list filter" in a "second filter phase." E-mail messages that are not on the guest list filter (G-I) are moved into a waiting room folder 20.



Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 5

PATENT

McCormick then discloses that end users can update the automatic discard filter 12 with e-mail messages (G) the end user selects from waiting room folder 20. E-mail messages that are caught by the automatic discard filter 12 (D-F) are simply placed in trash 16.

As noted and further emphasized, McCormick is a classic example of a "passive" system, because, it simply filters-out e-mail messages for end-users. As seen above, server 46 is used to update automatic discard filter 12, so that incoming e-mails that are unwanted may automatically be filtered-out for end-users. McCormick does not describe anything about taking pro-active measures to stem the tide of unwanted e-mail messages. Thus, for example, if ten copies of the same unwanted e-mail message are received by ten different end-users, each of the ten end-user computers will receive the unwanted e-mail, but then discard the unwanted e-mail. Further, if 1000 copies of the same unwanted e-mail message are received by 1000 computers, the e-mail message must again be received and filtered-out by 1000 computers. Accordingly, McCormick, does not contemplate taking any "pro-active" actions to stop the spammer from sending e-mails in the first place. Further, the burden of fighting SPAM remains upon the McCormick system.

Zmail also discloses yet another "passive" system that provides unwanted e-mail filters for users. Zmail, however, does nothing disclose taking any action to prevent unwanted e-mail messages from "spammers" to be sent to them in the first place. In the reference, Zmail is simply described as an add-on for an e-mail client application. This add-on simply gives an e-mail recipient the ability to add an e-mail sender's address to a filter-out list. Similar to McCormick, Zmail simply filters out e-mail messages that an end-user receives, and no additional actions are performed to reduce unwanted e-mail messages from being sent in the first place. Further, the burden of fighting SPAM remains upon the end-user. SPAM continues and is not stopped!

Courtney appears to be an article describing possible Federal Trade Commission (FTC) regulation of "spam." Courtney describes that the FTC currently has the power to "Crack down" on unfair and deceptive e-mail practices, ¶3, by obtaining court orders to shut down or to fine violators, ¶3. Courtney also describes the formation of a private organization of marketers called the "Internet marketing Council." ¶7. Courtney describes that members of the IMC must give customers a way to "opt-out" from receiving messages. ¶8. Courtney also describes another industry group called the "Direct marketing Association" that describes that members must offer an "opt-out" choice. ¶9.

Courtney then describes bills that were then pending. Courtney describes one bill that requires an advertiser to "include the sender's accurate contact information including physical address and phone." ¶10. Another bill describes giving the FTC power to "bust spammers who don't give an opt-out preference." ¶15. False return addresses are "punishable by a fine of up to \$5,000." ¶15. As can be seen, Courtney merely describes the FTC may be given powers to "bust spammers who don't give an opt-out preference," however Courtney makes no mention regarding enforcement of "opt-



Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 6

PATENT

out" requests, or the like. Further, Courtney makes no reference about a computer system, or how a computer system could be used to implement such functionality. Courtney is merely a high level guideline for certain high level procedures and does not show or suggest any of the inventions claimed herein.

Further details of each of these references will be discussed throughout the present appeal brief and more particularly below.

#### Prior Appeal

The present appeal is the second appeal the applicant has filed during the prosecution of the present application. The first appeal in this case was filed in 12/4/03, also in response to a final rejection. In response to the appeal, the Examiner withdrew the final rejection and issued a non-final action on 1/30/04.

The Applicant is perplexed by the Examiner's January 2004 rejection, because the grounds of rejection was virtually identical to the previous final action. In other words, the Examiner has not changed the grounds of rejection for all but one claims. The Examiner has delayed the consideration of patentability of the present case on the merits.

In the January 2004 action, the Examiner stated that he rejected the pending claims 1-10 on "new grounds." However, upon detailed review, the Examiner's "new" grounds of rejections of claims 1-10, were identical to the old grounds. The Examiner stated in January 2004 that:

*Applicant's amendment filed 12/04/2003 with respect to claims 1-12 have been considered but are moot in view of the new ground(s) of rejection." Page. 2, ¶2 (Emphasis added).*

In the final office action dated 9/21/04, the Examiner stated his "new" grounds of rejection on page 2, ¶7:

*Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).*

This statement is a carbon copy of the express language used in the rejection in the action mailed 05/05/2003. For the Examiner's convenience, Applicant has provided his statement on page 3, ¶5 below:

*Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCormick et al. (U.S. Patent No. 6,023,723) in view of "Here is a zmail ban-spam button" (07 October 1997).*

The additional comments by the Examiner are also the same. Accordingly, the Examiner has not actually provided any new grounds for rejection of claims 1-10. Instead, he has clearly delayed the prosecution of the claims in this case.

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 7

PATENT

A. Claims 1, 3, 4, 6-10, 13, 15, 16, 18 and 19

It is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding the above claims.

To establish prima facie obviousness, the Examiner must meet three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See Manual of Patent Examining Procedure § 2143 (2000) (collecting cases).

Regarding the third criterion, it is respectfully submitted that the Examiner has failed to show that the cited references teach or suggest all the claim elements. Appellant does not admit that the first and second criteria noted above have been satisfied. Rather, Appellant focuses on the third criterion that has clearly not been met. Claim 1 recites "a policing server coupled to each of the plurality of clients through the wide area network of computers, the policing server being adapted to receive the indication from at least one of the clients," as well as other features.

The term "policing server" is given a special meaning by the patentee:

*a policing server: a server that performs actions to reduce the incidence of further SPAM e-mail messages sent from one or more spammers.*

This definition is fully supported by the specification. As discussed above, both the provisional application and the present patent application disclose that "policing servers" perform "pro-active" actions in response to an unwanted e-mail, actions that are more than merely updating an e-mail filter. Examples of "pro-active" actions disclosed include, contacting the spammer's ISP, contacting governmental authorities to impose fines and levy penalties on the spammer, initiating private legal action against the spammer, submitting the spammer's ISP to a black list, and the like.

As discussed above, because the "policing server" is pro-active, actions are performed to stop the spammer from sending further e-mails. This is in stark contrast to McCormick or Zmail, where mere e-mail filters are set, but nothing is done to attempt to stop the spammer from sending further e-mails.

The Examiner has previously cited McCormick as disclosing a "policing server." Specifically, the Examiner cited col. 6, lines 34-38, col. 7, lines 45-48, the address filter server 22 as being a "policing server." Final Office Action 9/21/04, p. 3.

In light of the definition of the term "policing server," The Examiner's assertion is respectfully traversed. As seen in McCormick, address filter server 22 is merely a server that receives e-mail filters and re-distributes e-mail filters. Nowhere in McCormick is there any discussion about the server performing any action to reduce and preferably stop the spammer from sending further SPAM e-mail from the spammer. Instead, both McCormick and Zmail, simply "duck their heads down" and filter-out incoming e-mail, which has not been effective. Clearly, neither McCormick nor Zmail,

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 8

PATENT

alone or in combination show or suggest the claimed policing server coupled to each of the plurality of clients through the wide area network of computers, as recited. The present policing server is adapted to receive the indication from at least one of the clients. Additionally, such references also fail to show or suggest the further combination of the SPAM icon on the display, which is adapted to send the indication from the client to the policing server. Accordingly, these claims are patentable under 35 U.S.C. §103.

B. Claims 2 and 14

It is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding claims 2 and 14. Claims 2 and 14 should at least be patentable for substantially the same reasons as claims 1 and 13, respectively, and for the additional limitations they recite.

In the Office Action dated 9/21/04, the Examiner stated that zmail provided a "system message" of "permission denied" to the spammer. In contrast, claims 2 and 14 recite reporting an unauthorized e-mail message to the "policing server." As discussed above, the "policing server" is not the same as the spammers' server. That is, the claimed policing server is absolutely not the spammer's server in the preferred embodiment. Accordingly, claims 2 and 14 are patentable for at least these reasons.

C. Claims 5 and 17

The Examiner has also failed to make a prima facie showing of obviousness regarding claims 5 and 17. Claims 5 and 17 should at least be patentable for substantially the same reasons as claims 1 and 13, respectively, and for the additional limitations they recite.

Additionally, McCormick fails to show or suggest that the policing server comprises a log of the unsolicited e-mail communication as recited by claim 5. Here, the Examiner cited McCormick Figure 3 and column 4 lines 48-56, reproduced below:

*"These new addresses are periodically and automatically transmitted to a address filter server 22 provided at the remote central location 46. Based upon numerical and temporal factors as described hereinafter, these addresses are included on the current filter list associated with the address filter server 22 stored in a filter database associated with a database server 24 in communication with the address server 22."*

Clearly, the language above has absolutely nothing to do with the policing server maintaining the log of unsolicited e-mail communications, as claimed. At best, McCormick seems to illustrate that addresses are included on the current filter list with the address filter server stored in the filter database. Logging e-mail communication in the manner claimed is not shown or suggested. Accordingly, claims 5 and 17 are patentable.

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 9

PATENT

D. Claims 11, 12 and 20

Additionally, it is respectfully submitted that the Examiner has failed to make a prima facie showing of obviousness regarding claims 11, 12 and 20. Claim 11 was rejected under 35 U.S.C. §103(a) as being unpatentable over the combined system of McCormick, Zmail in view of Courtney.

The Examiner cited Courtney as teaching a governmental authority. Office Action 9/21/04, p. 6. However, the cited passage simply states that the FTC has the ability to reduce deceptive e-mail practices, and that pending bills may give FTC the ability to force spammers to give an "opt-out" preference. Nothing in Courtney teaches the governmental authority having a policing server, as recited.

Even if it is asserted claims 11, 12 and 20 are obvious in view of the combination of McCormick and Zmail and Courtney, such an assertion is also traversed. As discussed above, Courtney merely describes a proposed power of the FTC to make spammers give an opt-out preference. Courtney fails to suggest any mechanism for performing this action, for example, the FTC could simply receive telephone complaints and file a lawsuit. Further the FTC is merely a collection of government workers and no mention is made about a "policing server" as recited in claims 1 and 13. Additionally Courtney merely discusses the FTC making spammers give an opt-out preference, but does not make any reference to receiving indications of unsolicited e-mail messages as recited in claims 1 and 13.

Additionally, the Examiner has not given any reason as to why one of skill in the art would have been motivated to combine the references. As discussed above, McCormick and Zmail describe a reactive system that merely sets up e-mail filters and then uses them. In contrast, Courtney merely describes a bill that may allow the FTC to force spammers to provide "opt-out preferences." The former references do not contemplate nor suggest having any third-parties involved in filtering-out e-mails. Further, the Courtney reference does not even suggest combining the described capability with any existing system. Accordingly, the references do not give any motivation or suggestion be combined, and the Examiner has not demonstrated any other motivation to combine these references.

Even if the references could be combined as asserted by the Examiner, the combination does not disclose the elements in claims 11, 12, or 20. As discussed, McCormick and Zmail describe an e-mail filtering system, and for sake of argument, assume that Courtney describes an FTC system that "busts spammers who don't give an opt-out preference." It is asserted that the combination does not disclose the missing elements. For example a combination would be an FTC system that has an e-mail filtering capability, and the ability to "bust spammers who don't give an opt-out preference." These two separate functions are distinct and still do not disclose all the elements recited in claims 11, 12, and 20. In light of the above reasons, claims 11, 12, and 20 are patentable.

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 10

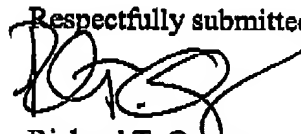
PATENT

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. This Appeal Brief is filed in triplicate.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



Richard T. Ogawa  
Reg. No. 37,692

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, 8<sup>th</sup> Floor  
San Francisco, California 94111-3834  
Tel: (650) 326-2400  
Fax: (650) 326-2422  
RTO:rto  
60426877 v1

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 11

PATENT

**APPENDIX OF CLAIMS**

1. (Previously presented) A system for policing an unsolicited e-mail communication comprising:

a plurality of clients, each coupled together using a wide area network of computers, the wide area network of computers comprising an Internet, each of the clients being adapted to send an indication of an unsolicited e-mail message through an e-mail device for a display;

a policing server coupled to each of the plurality of clients through the wide area network of computers, the policing server being adapted to receive the indication from at least one of the clients;

—wherein the e-mail device comprises an SPAM icon on the display, the SPAM icon being adapted to send the indication from the client to the policing server.

2. (Previously presented) The system of claim 1 wherein the policing server is adapted to report the unauthorized e-mail message.

3. (Original) The system of claim 1 wherein the policing server is adapted to update a local e-mail filter file for the client in response to the unsolicited e-mail communication.

4. (Original) The system of claim 1 wherein each of the clients comprise an updated e-mail filter file from the policing server.

5. (Previously presented) The system of claim 1 wherein the policing server comprises a log of the unsolicited e-mail communication.

6. (Original) The system of claim 1 wherein the unsolicited e-mail message is SPAM.

7. (Original) The system of claim 1 wherein the display comprises a browser program, the browser program being coupled to the e-mail device.

8. (Original) The system of claim 1 wherein each of the plurality of clients is for a different user, where each user is capable of sending the unsolicited e-mail message to the policing server.

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 12

PATENT

9. (Previously presented) The system of claim 1 wherein the policing server comprises a plurality of SPAM filters.

10. (Original) The system of claim 1 wherein each of the clients is coupled to the wide area network of computers through an internet service provider.

11. (Previously presented) The system of claim 1 wherein the policing server is provided at a governmental authority.

12. (Previously presented) The system of claim 1 wherein the policing server is from an enforcement agency.

13. (Previously Presented) A system for policing an unsolicited e-mail communication comprising:

a client coupled to a wide area network of computers, wherein the wide area network of computers comprises the Internet, wherein the client is adapted to receive an unwanted e-mail message from a sender, and wherein the client is adapted to send an indication of the unwanted e-mail message;

a policing server coupled to the client through the wide area network of computers, wherein the policing server is adapted to receive the indication of the unwanted e-mail message, and wherein the policing server is adapted to perform an action to reduce the incidence of unwanted e-mail messages sent from the sender in response to the indication of the unwanted e-mail message.

14. (Previously Presented) The system of claim 13 wherein the policing server is adapted to report the unauthorized e-mail message.

15. (Previously Presented) The system of claim 13 wherein the policing server is adapted to update a local e-mail filter file for the client in response to the unsolicited e-mail communication.

16. (Previously Presented) The system of claim 13 wherein each of the clients comprise an updated e-mail filter file from the policing server.

17. (Previously Presented) The system of claim 13 wherein the policing server comprises a log of the unwanted e-mail communication.

Stephen Y.F. Pang  
Application No.: 09/353,537  
Page 13

PATENT

18. (Previously Presented) The system of claim 13 wherein the client comprises an e-mail client program.

19. (Previously Presented) The system of claim 13 wherein the client comprises a browser program.

20. (Previously Presented) The system of claim 13 wherein the policing server is provided at a governmental authority.

60426877 v1